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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/056,591

01/24/2002

Todd S. Sones

074240.00002

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7590

11/04/2003

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EXAMINER

SMITH, RICHARD A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,591

Applicant(s)

SONES, TODD S.

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 15 August 2003 have not been approved for the following reason.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "17" in figure 1 has been used to designate both the grip and the putter blade. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to because of the following informality: The problem with "17" as noted in the drawings is also in the specification, see page 5, lines 6, 21, and 24.

Claim Objections

3. Claims 1-4 are objected to because of the following informality: In claim 1, "The method" starting at the beginning of the line should be --A method--.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 3:

In the first Office action, the examiner stated that "Furthermore, the phrase 'pivoting the club head about an axis parallel to the intended direction of ball movement' is indefinite because it is unclear where and in what context the pivoting occurs. Is this the golfer pivoting through the stroke wherein his pivoting axis (basically through the shoulders) is parallel to the intended direction of ball movement? Or again, is this describing the pivot point at 19 for the apparatus as shown in figure 3 which is not claimed?"

In view of the argument presented in the Applicant's response filed 15 August 2003, that this claim is broadly written to cover both a club as shown in figure 1 and the apparatus as shown in figure 3. However, the claim as written does not preclude pivoting through the shoulders when in the basic stance to get the putter head to lie flat with respect to the ground. Therefore, the claim is incomplete for omitting essential structural cooperative relationships of elements,

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such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. In addition to the pivoting of the club head being about an axis parallel to the intended direction of ball movement, the omitted structural cooperative relationship is that the pivot axis must pass through a portion of the golf putter club.

Claim 4: "after the length has been selected" makes the claim indefinite because there is no preceding limitation that discloses that a length has been selected. Claim 1 addresses limitations for taking a measurement to determine the proper length of a putter club, but does not disclose that this said (measured) length has been selected or that a putter club having said (measured) length has been selected.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1 and 2 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over "Arm Your Stroke, Sink More Putts" by Todd Sones [hereinafter Sones] in view of How To Buy A Putter, Golf Buyers Guide, DicksSportingGood.com [hereinafter Dicks].

Sones discloses a method (last paragraph of the section titled the set-up) of individually fitting a golf putter for an individual golfer which comprises positioning the golfer on level ground, determining the proper length of a golf putter club by balancing the golfer's weight over the ball of the foot, simultaneously tilting his torso forwardly about his hips to position his eyes directly above a ball positioned on the ground, and simultaneously positioning his hands on the grip directly below his shoulders and forward of his legs and torso.

Sones does not disclose positioning the golfer with his hip sockets directly above his heels, measuring the distance from the heel of his palm to the ground at the inside edge of the ball, and the method of claim 2.

With respect to positioning the golfer with his hip sockets directly above his heels: The balance of the golfer's weight over the balls of his feet and the compact positioning of the golfer as shown in the bottom right-hand figure on page 81 of Sones appears to meet this limitation. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to position the hip sockets directly above the heels, as suggested by Sones, in order to obtain a compact putting stance while keeping the balance of the golfer over the balls of his feet.

Dicks teaches that the distance to measure with respect to the golfer is just above the top of his hands in order to obtain a putter that is neither too short nor too long in order to have a proper view of the putting line. Therefore, it would have been obvious to one of ordinary skill in the art

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at the time of the invention to modify the method, i.e., the proper stance, taught by Sones, by adding a measurement to just above the top of the hands, as taught by Dicks, in order to properly size a putter so that it is not too long or too short to throw off the view of the putting line.

With respect to measuring the distance from the heel of the palm to the inside edge of the ball as claimed by Applicant: Dicks discloses that the measurement is made to the top of the hands and Sones in the bottom right-hand figure on page 81 shows the putter wherein it appears that the shaft is directly in line with an inside edge of the ball when the golfer is in the proper putter position setup and teaches in the column titled "The Stroke" that this position places the putter head at the lowest point of the arc during the stroke. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to measure from the heel of the palm, as suggested by Dicks, to the inside edge of the ball, as suggested by Sones, in order to obtain a putter which allows the user to maintain the proper stance while providing a smooth swing and proper addressing of the golf ball.

With respect to the method of claim 2, i.e., taking the measurements of the sides and using the Pythagorean Theorem to calculate the hypotenuse: this is a very well known formula for calculating a distance when said distance meets the requirements of said theorem. Therefore, the direct measurement method, taught by Sones as modified by Dicks, and that of claim 2 using the Pythagorean Theorem is considered to be equivalent to the direct measurement, since 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained if one is used instead of the other, as long as the measured distance represents the proper length of a golf putter club, as already taught by Sones

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and Dicks, and 2) the measurement method claimed by Applicant and direct measurement method used by Sones as modified by Dicks are well known alternate types of measurement methods which will perform the same function, if one is replaced with the other, of measuring the proper length of a golf putter club.

8. Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Sones and Dicks as applied to claims 1 and 2 above, and further in view of U.S. 6,142,884 to Yim.

Sones and Dicks together teach all that is claimed as discussed in the above rejections of claims 1 and 2 except for the limitations of claim 3.

Yim discloses an apparatus having golf putter club wherein the club head is pivoted about an axis parallel to the intend direction of the ball movement to position the bottom of the club flat on the ground to provide a proper lie. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the axis and pivoting, as taught by Yim, to the golf putter club, taught by Sones and Dicks, in order to adjust the club head to have a uniform ground clearance over its length.

With respect to the method of claim 3: the method steps will be met during the normal operation of the method, taught by Sones and Dicks, as modified by the normal operation of the apparatus, taught by Yim.

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9. Claim 4 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Sones and Dicks as applied to claims 1 and 2 above, and further in view of U.S. 6,379,264 to Forzano.

Sones and Dicks together teach all that is claimed as discussed in the above rejections of claims 1 and 2 except for the limitations of claim 4.

Forzano discloses adjusting the weight of the putter head and grip to provide a selected swing weight in order to suit a golfer's putter stroke and to change the location of the sweet spot (column 3, lines 41-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the head and grip, taught by Sones and Dicks, by altering the weight, as taught by Forzano, in order to provide the selected swing weight based its suitability to the golfer's putting stroke and to change the sweet spot.

Response to Arguments

10. Applicant's arguments filed 15 August 2003 have been fully considered but they are not persuasive.

In response to applicant's argument regarding Sones describing a proper stance and posture and Dick not describing measuring the club length as described and claimed: the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into

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the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case Sones discloses a proper stance and posture while holding and swinging a putter club. Dick discloses that for a person's frame or stance that a measurement needs to be taken in order to assure that a putter club is not too long or too short to throw off the view of the putting line. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that if Sones discloses a proper stance and posture with a club in hand, then Dick would teach that a measurement needs to be taken in order to select the correct club for the proper stance and posture, taught by Sones, since the proper stance of Sones could not be taken by the user if the club was too long or too short.

With respect to Forzano '264 and changing the swing weight in response to changing, i.e., selecting, the club length: This argument is not persuasive since the examiner used Sones as modified by Dick for the teaching of taking a measurement and selecting a club length. Furthermore, the claim(s) does not address a swing weight before selection of a club length and then adjusting said swing weight after selection which appears to be a necessary condition for the Applicant's argument. In other words, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant

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relies (i.e., changing the swing weight in response to changing, i.e., selecting, the club length) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

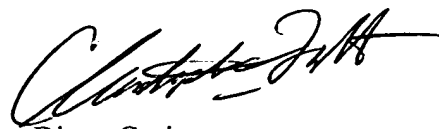
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related methods.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Smith whose telephone number is (703) 305-0647. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

RAS
October 29, 2003

CHRISTOPHER W. FULTON
PRIMARY EXAMINER